



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/971,338 11/17/97 LEE

S GDF-1

EXAMINER
----------

ALLEN, M

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED:

06/19/01

HM22/0619  
CUSHMAN DARBY & CUSHMAN  
IP PROP GRP OF PILLSBURY MADISON & SUTRO  
1100 NEW YORK AVENUE  
NINTH FLOOR EAST TOWER  
WASHINGTON DC 20005-3918

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 08/971,338	Applicant(s) LEE, SE-JIN	
	Examiner Marianne Allen	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-10 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-10, 22-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Response to Arguments***

Applicant's arguments filed 4/3/01 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 101***

Claims 4-10 and 22-33 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial and credible utility or by a well established utility.

This rejection is maintained for reasons of record as applied to claims 4-10, 22-23, and 31-33.

Claims 4-10, 22-23, and 31-33 are directed to GDF-1 proteins. Claims 24-30 are directed to methods of purifying GDF-1 proteins. The protein products lack patentable utility for the reasons set forth below; therefore, the methods of purification (claims 24-30) to make these protein products must also lack patentable utility.

The specification discloses using the GDF-1 proteins to make antibodies. This is not a specific asserted utility because it is generally applicable to any protein

Applicant argues that there are "at least three utilities for GDF-1 that support the claimed invention, any one of which would be adequate to provide a practical utility." The first named utility in the response is use as a specific marker for a tumor arising from a cell type that normally expresses the gene or protein. The examiner notes that no tumors have been identified

Application/Control Number: 08/971,338

Art Unit: 1631

in the specification as arising from a cell type that normally expresses the GDF-1 gene or protein. Thus, this is not a specific, substantial, and credible utility nor a well-known utility for GDF-1. The second named utility in the response is a marker for a particular cell lineage. Applicant references an abstract to Thibodeau et al. (1989). The examiner notes that GDF-1 has not been demonstrated to be a marker for a particular cell lineage in the specification nor is this use asserted. Thus, this is not a specific, substantial, and credible utility nor a well-known utility for GDF-1. Thibodeau et al. can be distinguished from the instant application at least because it discloses producing monoclonal antibodies and screening them to find monoclonal antibodies with unique patterns of immunoreactivity. Some antibodies found are characterized as regional, cell-lineage, cell-cycle, or extracellular material-associated markers. Again, GDF-1 has not been characterized in the specification as a marker. The third named utility in the response is a cell survival molecule in neuronal culture. The examiner notes that the specification does not positively assert that GDF-1 is a cell survival molecule in neuronal culture. As pointed to by applicant in the response the specification states, "If GDF-1 possesses a similar activity...GDF-1 will **likely** prove useful..." (emphasis added). Again, the examiner maintains that the specification clearly discloses that at the time of the invention the specific biological activity associated with GDF-1 was not known. Applicant again proffers the Ebendal declaration. The examiner notes that none of the comments in the prior Office action concerning the deficiencies of the Ebendal declaration have been addressed. The examiner further notes that the Ebendal declaration does not show that GDF-1 has an activity also known to be possessed by activin at the time of the invention. As such, applicant's arguments on page 7 of the response with respect

Application/Control Number: 08/971,338  
Art Unit: 1631

to activin appear to be misplaced. Thus, use as a cell survival molecule is not a specific, substantial, and credible utility nor a well-known utility for GDF-1.

As set forth in the prior Office action, the specification discloses that the GDF-1 proteins may have any of a number of biological activities based upon similarity to members of the TGF- $\beta$  superfamily. It is noted that these activities vary quite widely. The similarities between particular GDF-1 proteins and the TGF- $\beta$  family members range from 26-52% on the amino acid level. (See specification page 12, lines 8-20.)

The specification makes clear that further experimentation is necessary to confirm the activity and uses of the protein. The need for such research clearly indicates that the protein and/or its function is not disclosed as to a currently available or substantial utility.

***Claim Rejections - 35 USC § 112***

Claims 4-10 and 22-33 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

This rejection is maintained for reasons of record.

Claims 4-7, 22, 24-25, and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

This rejection is maintained for reasons of record.

The claims are directed to mammalian GDF-1 proteins (claim 4), unspecified GDF-1 proteins (claim 24), and hamster GDF-1 proteins (claim 6). The specification provides the sequences of mouse and human GDF-1. The specification further indicates that they have less conservation across species (69%) than other members of the TGF- superfamily. (See page 31.)

The specification contains no disclosure of the expected structure for other members of this family or what structural features identify a protein as a GDF-1 protein. Furthermore, as the activity of GDF-1 was not known at the time of the invention, the specification does not enable any assays for identification of GDF-1. As such, none of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Applicant's arguments are unpersuasive. Applicant is requested to explain how one of ordinary skill in the art would screen for GDF-1 protein activity when no activity was known at the time of the invention.

Applicant's comments regarding U.S. Patent Nos. 6,008,017 and 6,074,841 are again not germane. The inventors, assignee, and subject matter are not shared by the instant application. The issued claims are not directed to GDF-1. Each application is examined independently and on its own merits.

It is believed that all pertinent arguments have been addressed.

**Conclusion**

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Friday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028. Official FAX communications may be directed to either (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Marianne P. Allen*

MARIANNE P. ALLEN  
PRIMARY EXAMINER  
GROUP 1600

*AU1631*